

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NOBUO SEKINE,
TAKEHIKO YOKOSUKA,
MASASHI ANDOH and
YOSHIAKI OKAWARA

Appeal No. 1998-3289
Application 08/362,167¹

ON BRIEF

Before COHEN, FRANKFORT and BAHR, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 1, 2, 4 through 7, 10, 11, 13, 14, 18 and 20

¹ Application for patent filed December 22, 1994.

Appeal No. 1998-3289
Application 08/362,167

through 29, as amended subsequent to the final rejection (Paper No. 10). Claims 3 and 19 have been canceled. Claims 8, 9, 12, 15 through 17, and 30 through 40, the only other claims remaining in the application, stand withdrawn from further consideration by the examiner, pursuant to 37 CFR § 1.142(b), as being drawn to a nonelected species.

Appellants' invention addresses a ballpoint pen. An understanding of the invention can be gained from a reading of exemplary claims 1 and 18, copies of which appear in the APPENDIX to the main brief (Paper No. 20).

As evidence of obviousness, the examiner has applied the documents listed below:

Shea 1968	3,418,057	Dec. 24,
Hori 1979	4,139,313	Feb. 13,
Yokosuka	4,457,644	Jul. 3, 1984
Otsuka	4,842,433	Jun. 27, 1989
Kupferschmidt (European Patent) ²	91,516	Oct. 19, 1983

² Translation attached.

Appeal No. 1998-3289
Application 08/362,167

Galli
(Great Britain)

2,114,065

Aug. 17, 1983

Claims 1, 2, 4 through 7, 10, 11, 13, 14, 18, and 20 through 29 stand rejected under 35 U.S.C. § 103 as being unpatentable over either Yokosuka, Otsuka, or Galli (British document) in view of Hori, Kupferschmidt (European Patent), and Shea.

The full text of the examiner's rejection and response to the argument presented by appellants appears in the answer (Paper No. 21), while the complete statement of appellants' argument can be found in the main and reply briefs (Paper Nos. 20 and 23).

OPINION

As a consequence of our review of appellants' specification and claims, the applied teachings,³ and the

³ In our evaluation of the applied documents, we have considered all of the disclosure of each reference for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA

Appeal No. 1998-3289
Application 08/362,167

respective viewpoints of appellants and the examiner, we make the determination which follows.

This panel of the board is constrained to reverse the obviousness rejection on appeal.

Sound evidence is required to establish a prima facie case of obviousness. More specifically, appropriate evidence is that which would have been suggestive of the presently claimed invention to one having ordinary skill in an art, without reliance upon appellants' own teaching.

Setting aside in our minds appellants' disclosed invention, and assessing the examiner's proffered prior art as a whole, we at once perceive a lack of suggestion therein for the defined ballpoint pen of claims 1 and 18, respectively.

1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

Appeal No. 1998-3289
Application 08/362,167

The examiner does not dispute the characterization in appellants' tabulation (main brief, page 5) to the effect that the reference teachings are "silent" with respect to the parameters D, T, and L and any relationship therebetween. Instead, the examiner asserts (answer, page 4), for example, that the relationship set forth in claim 1 is disclosed when each of the reference drawings (not to scale) has been "measured by a ruler", since "it would appear that this relationship is

conventional in the art." We, of course, recognize that a drawing is available as a reference for all that it teaches a person of ordinary skill in the art. See In re Meng, 492 F.2d 843, 181 USPQ 94 (CCPA 1974). However, on the facts of the present case, this panel of the board concludes that the overall reference teachings, evaluated alone and in combination, would not have suggested the particular relationships expressly set forth in each of independent claims 1 and 18. Specifically, scaling unscaled patent drawings for precise dimensions clearly yields a speculative assessment, and is not sound prior art fact finding for supporting the obviousness of the claimed invention.

The examiner has simply failed to provide evidence from the ballpoint pen art establishing a factual basis upon which to conclude that the now claimed invention would have been obvious to those having ordinary skill. As explained, supra, the only evidence before us neither reveals that those with ordinary skill in the art related the parameters of L, D, and T relative to one another in designing a pipe projecting portion, nor discloses that the dimensions of known pipe

Appeal No. 1998-3289
Application 08/362,167

projecting portions, in fact,

Appeal No. 1998-3289
Application 08/362,167

fall within the claimed expressions of claims 1 and 18,
respectively. A proper rejection under 35 U.S.C. § 103
mandates sound evidence of obviousness.

The decision of the examiner is reversed.

REVERSED

)	
IRWIN CHARLES COHEN))
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

ICC/dal

Appeal No. 1998-3289
Application 08/362,167

SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 PENNSYLVANIA AVENUE, NW
WASHINGTON, DC 20037